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09/675,025	09/28/2000	Charles Eric Hunter	**OO-0140	7653

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EXAMINER
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STRANGE, AARON N

ART UNIT	PAPER NUMBER
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2453

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/675,025	<b>Applicant(s)</b> HUNTER ET AL.	
	<b>Examiner</b> AARON STRANGE	<b>Art Unit</b> 2453	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 134,135,137-147,149-169 and 171-176 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 134,135,137-147,149-169 and 171-176 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20081121</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. As noted by Applicant (Remarks 12), an art rejection of claim 135 was inadvertently omitted from the Office action of 7/28/2008. However, the subject matter of claim 135 is taught by Russo, a reference of record, as set forth in the Office action of 4/19/2007. Accordingly, the rejection of claim 135 (and 147, which is substantially identical in scope) has been reinstated and appears below.

Since the rejection of claim 135 has been reinstated, the present Office action is made non-final. Applicant is reminded that an applicant whose claims have been twice rejected (as in the present application) may appeal from the decision of the Examiner to the Board by filing a timely notice of appeal, regardless of whether the claims have been finally rejected. See 37 C.F.R. § 41.31 and MPEP § 1204 (I).

2. With regard to claim 134, and Applicant's assertion that Beach "cannot automatically select programs to be recorded at the user location because it has to know in advance which programs are being broadcast and at which times" (Remarks 11), it is noted that the rejection of claim 134 is based on the combination of Walters and Beach.

Walters teaches a system substantially as claimed, including automatic selection of video programs based on classification information (VID), but fails to teach using descriptive information other than specific identification as the classification information. Beach teaches selection of video programs based on classification information other

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that a specific identification (actor, director, rating, etc). The architecture of Beach is not relied upon in the rejection since Walters already contains an architecture substantially identical to the claimed invention. The rejection does not purport to bodily incorporate Beach's system into Walters, but merely relies upon Beach's teaching of program selection based on non-specific identification information.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 134, 137-139, 141, 145, 146, 149-151, 153, 157, 158, 160, 164-169, 171-173, 175, and 176 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walters et al. (US 5,440,334) in view of Beach et al. (US 6,728,713).

5. With regard to claim 134, Walters discloses a method comprising:

transmitting a plurality of video programs to a plurality of consumer devices at respective consumer locations (programs are transmitted to all subscriber locations)(col. 3, ll. 13-24); wherein each said consumer device comprises a mechanism configured to recognize classification information contained in received headers (all video programs contain a VID that uniquely identifies them that compared to ID of ordered programs by

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the device)(col. 4, ll. 19-22; col. 11, ll. 39-49), a mechanism to automatically select for storage video programs from the plurality of video programs having a defined level of match between classification information associated with the video programs and preference information associated with the consumer device (programs with a VID matching an ordered program are selected for storage)(col. 4, ll. 2-24); and

transmitting classification information in a header associated with at least one of the plurality of video programs (VID may be sent in a header)(col. 11, ll. 29-32).

Walters fails to specifically disclose providing a mechanism to automatically overwrite stored digital data content with the automatically selected video programs according to one or more defined criteria or that the classification information comprises descriptive information other than specific identification of the video program associated with the header.

Beach discloses a similar system for storing and playback of video programs at a client device based on user preferences. Beach teaches transmitting descriptive information (television viewing objects are sent using slices)(col. 11, ll. 10-13; fig. 1) to a client, other than specific identification of the video program(program objects contain information about the program such as the actors, director, rating, etc.), and using the information at the client to select video programs for storage (col. 17, l. 15 to col. 18, l. 37). This would have been an advantageous addition to the system disclosed by Walters since it would have allowed users to have programs automatically stored for them based on preference information, providing the user with content likely to be of interest without requiring them to specifically identify it.

Beach additionally teaches providing a mechanism to automatically overwrite stored digital data content with automatically selected video programs according to a defined criteria (newly downloaded programs replace previously stored programs based on various criteria)(col. 18, ll. 40-61). This would have been an advantageous addition to the system disclosed by Walters since it would have allowed a small storage area to appear much larger (Beach; col. 18, ll. 51-54) and given the user immediate access to a variety of programs of interest to the user without waiting for them to be received.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to consider preference information when deciding which programs to store and to automatically overwrite previously stored digital data content with newly selected programs since it would have given the user immediate access to programs of interest or potential interest and allowed a smaller storage space to appear larger to the user.

6. With regard to claim 137, Beach further discloses that the defined criteria is that oldest stored video programs are overwritten with the automatically selected video programs (expired programs are overwritten)(col. 18, ll. 40-42 and 59-61).

7. With regard to claim 138, Beach further discloses that a defined criterion is that older releases of stored video programs are overwritten with automatically selected video programs (newer versions replace older versions previously stored)(col. 7, ll. 11-18).

8. With regard to claim 139, Beach further discloses that a defined criterion is that stored digital data content which least fits a preference of the consumer location is overwritten with automatically selected video programs (programs recorded based on inferred preferences lose all scheduling conflicts)(col. 18, ll. 54-57; col. 19, ll. 18-21).

9. With regard to claim 141, Walters further discloses encoding the transmitted video programs with data permitting playback only on a playback device with a compatible decoder (programs must be decoded prior to playback)(col. 9, ll. 47-51).

10. With regard to claim 145, Walters further discloses that transmitting a plurality of video programs is carried out by direct broadcast satellite transmission on multiple channels in compressed time format (col. 3, l. 41 to col. 4, l. 9).

11. Claims 146, 149-151, 153, 157, 158, 160, 164-169, 171-173, 175 and 176 are rejected under the same rationale as claims 134, 137-139, 141 and 145, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

12. Claims 135, 140, 147, 152, 159 and 174 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walters et al. (US 5,440,334) in view of Beach et al. (US 6,728,713) further in view of Russo (US 6,025,868).

13. With regard to claim 135, while the system disclosed by Walters and Beach shows substantial features of the claimed invention (discussed above), it fails to disclose billing a consumer once a video program has been selected for viewing that has been previously automatically selected for storage based upon preference information.

Russo discloses a similar system for storing video programs for playback at a client device. Russo teaches billing the customer once a video program has been selected for viewing that has been previously recorded (col. 5, ll. 1-6; col. 6, ll. 25-32; col. 11, ll. 57-59). This would have been an advantageous addition to the system disclosed by Walters and Beach since it would have prevented users from being billed for content until it was selected for viewing, allowing the device to download content predicted to be of interest to the user without incurring charges.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to bill the customer once a video program has been selected for viewing that has been previously recorded in order to charge customers for content that is actually viewed.



14. Claims 147 is rejected under the same rationale as claim 135, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

15. With regard to claim 140, while the system disclosed by Walters and Beach shows substantial features of the claimed invention (discussed above), it fails to disclose that the automatically selected video programs are recorded on a removable and portable storage medium.

Russo discloses a similar system for storing video programs for playback at a client device. Russo teaches recording the video programs on removable, portable storage mediums (i.e., discs, tapes, etc)(col. 4, ll. 15-25). This would have been an advantageous addition to the system disclosed by Walters and Beach since it would have allowed users to transport their recorded programs to other locations for subsequent playback.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to record the video programs on removable, portable media to allow transport of the recorded programs.

16. Claims 152, 159 and 174 are rejected under the same rationale as claim 140, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

17. Claims 142-144, 154-156 and 161-163 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walters et al. (US 5,440,334) in view of Beach et al. (US 6,728,713) further in view of Banker et al. (US 6,005,938) further in view of Gilhousen et al. (US 4,613,901).

18. With regard to claims 142 and 143, while Walters and Beach disclose a substantial portion of the claimed invention (discussed above), they fail to specifically disclose that the transmitted video programs are encoded with time-based code keys A correlated with periodic time-based code keys B that are blanket transmitted to the plurality of consumer devices and time-based code keys C that are provided to consumer devices that are in good standing, wherein the playback device can only playback a video program if all three code keys have been received.

Banker discloses a similar system for distributing digital information to consumer locations via a network (col. 1, ll. 10-17). Banker teaches encoding video programs with time-based code keys A (time-based instance keys used for decoding program are transmitted in ECMs with the program)(col. 5, ll. 40-52; col. 6, l. 63 to col. 7, l. 8) that are correlated with time-based code keys C (session keys) that are provided to consumer locations within the plurality of consumer locations that are in good standing (session keys are provided as part of DEMM, and are time limited by information in AEMM)(col. 4, ll. 8-14, ll. 37-53) (See also col. 1, ll. 51-59). Use of these keys would have been an

advantageous addition to the system disclosed by Walters since they would have prevented content from being viewed by consumers who have not paid for it.

Gilhousen discloses a similar system for distributing video programs to subscribers and protecting the programs from unauthorized viewing (col. 1, ll. 17-20). Gilhousen teaches blanket transmitting a periodic time-based code key B (channel key) (col. 22, ll. 18-21) to all consumer locations within a particular category, such as class or service or type of customer (col. 21, ll. 43-44). Gilhousen further discloses that these keys are correlated with keys used to encode the transmitted programs (channel key is needed to produce working keys needed to decode the program)(col. 20, ll. 55-67). Using a blanket transmitted key correlated with the keys used to encode the transmitted programs would have been an advantageous addition to the system taught by Walters and Banker since it would have allowed scrambling/encryption of video programs to be enabled/disabled on a channel by channel and program by program basis rather than a user by user basis (Gilhousen; col. 22, ll. 24-28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use time-based keys as taught by Banker and Gilhousen to protect the transmitted video content from unauthorized viewing by parties that did not pay for the content, while retaining the ability to permit a program to be viewed by all subscribers without communicating directly with each individual subscriber.

19. With regard to claim 144, Walters further discloses receiving video program playback information from a consumer device at a central controller system periodically (i.e., monthly billing information) (col. 12, ll. 21-29). Banker discloses that the time-based code keys C are provided to the consumer location periodically (col. 1, ll. 57-59). The combined teachings of Walters and Banker would have taught or reasonably suggested to one of ordinary skill in the art to collect the billing information at the same time as the time-based code keys C are collected, since this would have allowed the system to bill the consumer when the keys are updated, to ensure that the consumer's account remains in good standing.

20. Claims 154-156 and 161-163 are rejected under the same rationale as claims 142-144, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

### ***Conclusion***

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Strange/  
Examiner, Art Unit 2453